

REMARKS

This is a full and timely response to the Office Action of July 1, 2004. Upon entry of this Fifth Response, claims 1-10 remain pending in this application.

If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

102 Rejections

It is well established that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

Claim 1

Claim 1 presently stands rejected under 35 U.S.C. §102 as allegedly anticipated by *Mayhew*. Claim 1 reads as follows:

1. In an iconic programming system, wherein the iconic programming system contains an existing network of connected icons, a computer-implemented method for tracing the execution of icons, the method comprising the steps of:
 executing a plurality of the icons via a run of a software program;
 setting a flag for each icon executed in the executing step, the flag corresponding with the each icon; and
 simultaneously highlighting each icon corresponding with each flag set in the setting step subsequent to the run of the software program.
(Emphasis added).

Applicant respectfully submits that *Mayhew* fails to disclose at least the features of claim 1 highlighted hereinabove.

In this regard, the Office Action states that "Mayhew does not explicitly disclose the steps of setting a flag for each icon executed thereby highlighting each icon being set by its

corresponding flag.” Thus, it appears that the Examiner is in agreement with the Applicant in this regard. However, the Office Action further states that:

“these steps must necessarily be inherent to such a method as Mayhew’s so as to provide the method a means for determining and keeping track of the execution status of each icon by setting a ‘True; indication to a ‘True/False’ flag that is associated to each executed icon during the executing step; thereby providing the method necessary status information to properly determine and display the highlighting of the plurality of icons.”

See Office Action, page 3.

Applicant respectfully disagrees with the Examiner’s assessment of the system disclosed in *Mayhew*. In this regard, to properly reject a claim under 35 U.S.C. §102, it is insufficient for the Patent Office to merely establish that a claimed feature may be or is likely to be included in a prior art system. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” M.P.E.P. §2112.

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Inherency, however, may not be established by probabilities or possibilities*. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added).

Thus, in the instant case, the relevant question is not whether “setting a flag for each icon executed” and “simultaneously highlighting each icon corresponding with each flag set in the setting step subsequent to the run of the software program” may be or even is likely to be performed by the system taught in *Mayhew*. It is incumbent upon the Patent Office to establish that the *Mayhew* system “necessarily” performs such functions.

As pointed out by the Office Action, *Mayhew* teaches a system that “during the application program procedure, the presentation of a graphical icon is modified...the icon’s presentation is modified to indicate completion of the execution of the associated job.” See

Mayhew, abstract, lines 10-11; abstract, lines 14-15); Office Action, page 5. Thus, it appears that as soon as execution of an associated job is complete, an icon is highlighted. Therefore, it is unnecessary in *Mayhew* to have flags corresponding to different icons and to track the execution of the application program procedure using such flags. Accordingly, Applicant asserts that it is not necessarily inherent that the *Mayhew* system implicitly “disclose[s] the steps of setting a flag for each icon executed, thereby highlighting each icon being set by its corresponding flag,” as alleged in the Office Action.

For at least the above reasons, Applicant submits that *Mayhew* fails to disclose explicitly or inherently the steps of “setting a flag for each icon executed in the executing step, the flag corresponding with the each icon” and “simultaneously highlighting each icon corresponding with each flag set in the setting step subsequent to the run of the software program,” as described by claim 1. Thus, the rejection of claim 1 under 35 U.S.C. §102 is improper and should be withdrawn.

Claim 2

Claim 2 presently stands rejected as unpatentable under 35 U.S.C. §102 as allegedly anticipated by *Mayhew*. Dependent claim 2 contains all features of its respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claim 2 should be allowed for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 3

Claim 3 presently stands rejected under 35 U.S.C. §102 as allegedly anticipated by

Mayhew. Claim 3 reads as follows:

3. In an iconic programming system, wherein the iconic programming system contains an existing network of connected icons, a computer-implemented method for tracing the execution of icons, the method comprising the steps of:

executing a plurality of the icons;

setting a flag for each icon executed in the executing step, the flag corresponding with the each icon;

receiving an input subsequent to the executing step; and

simultaneously highlighting, in response to the receiving step, each icon corresponding with each flag set in the setting step. (Emphasis added).

For at least the reasons set forth hereinabove in the arguments for allowance of claim 1,

Applicant submits that the cited art fails to disclose at least the features of claim 3

highlighted hereinabove. Thus, Applicant respectfully submits that the rejection of claim 3 is improper.

Further, claim 3 recites that a “plurality of the icons” are highlighted “in response to” the step of “receiving an input *subsequent to*” the step of executing the “plurality of icons.” (Emphasis added). As disclosed above in the arguments for allowance of claim 1, *Mayhew* discloses highlighting an icon, at run-time, once the job associated with the icon has been completed. Thus, it appears that the highlighting of any one icon is based on the status of its associated job and not necessarily on the status of another job associated with another icon. Moreover, there is no reason for at least two icons in *Mayhew* to be highlighted in response to an “input” that is received *after* the tasks for both of the icons have been completed.

In particular, it appears that one icon would be highlighted upon completion of its associated task, and the other icon would be highlighted upon completion of its associated

task. Thus, at least one of the icons would apparently be highlighted in response to an input that is received before the execution of the other icon is complete. The Office Action cites no “input” disclosed explicitly or inherently by *Mayhew* that would be received after the two icons have been executed and that would trigger the highlighting of both of the icons. Thus, Applicant asserts that *Mayhew* fails to disclose “executing a **plurality of the icons**,” “receiving an input **subsequent to the executing step**,” and “simultaneously highlighting, **in response to the receiving step**, each icon corresponding with each flag set is the setting step,” as described by claim 3. (Emphasis added).

For at least the above reasons, Applicant asserts that the 35 U.S.C. §102 of claim 3 should be withdrawn.

Claim 4

Claim 4 presently stands rejected under 35 U.S.C. §102 as allegedly anticipated by *Mayhew*. Claim 4 reads as follows:

4. In an iconic programming system, wherein the iconic programming system contains an existing network of connected icons, a computer-implemented method for tracing the execution of icons, the method comprising the steps of:
executing a plurality of the icons;
indicating which of the icons are executed in the executing step;
determining, subsequent to the executing step and based on the indicating step, that the plurality of icons have been executed; and
highlighting the plurality of executed icons in response to the determining step. (Emphasis added).

Applicant submits that *Mayhew* fails to disclose at least the features of claim 4 highlighted hereinabove.

In this regard, as disclosed above in the arguments for allowance of claim 1, *Mayhew* discloses highlighting an icon, at run-time, once the job associated with the icon

has been completed. Thus, it appears that the highlighting of any one icon is based on the status of its associated job and not necessarily on the status of another job associated with another icon. Moreover, there is no reason for at least two icons in *Mayhew* to be highlighted in response to a determination that occurs *after* the tasks for both of the icons have been completed.

In particular, it appears that one icon would be highlighted upon completion of its associated task, and the other icon would be highlighted upon completion of its associated task. Thus, at least one of the icons would apparently be highlighted in response to a determination that occurs before the execution of the other icon is complete. The Office Action cites no determination disclosed explicitly or inherently by *Mayhew* that would occur after the two icons have been executed and that would trigger the highlighting of both of the icons. Thus, Applicant asserts that *Mayhew* fails to disclose “executing a *plurality* of the icons,” “determining, *subsequent to the executing step*... that the plurality of icons have been executed” and “highlighting the plurality of executed icons *in response to the determining step*,” as described by claim 4. (Emphasis added).

For at least the above reasons, Applicant respectfully asserts that the 35 U.S.C. §102 of claim 4 is improper and should be withdrawn.

Claims 5 and 6

Claims 5 and 6 presently stand rejected under 35 U.S.C. §102 as allegedly anticipated by *Mayhew*. Dependent claims 5 and 6 contain all features of their respective independent claim 4. Since claim 4 should be allowed, as argued hereinabove, pending dependent claims 5 and 6 should be allowed for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Furthermore, these dependent claims recite

patentably distinct features and/or combinations of features that make them allowable, notwithstanding the allowability of their base claim 4.

For example, claim 5 recites “wherein the indicating step includes the step of setting, during the executing step, a plurality of flags respectively corresponding with the plurality of icons.” For at least the reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant asserts that the foregoing features of claim 5 are not disclosed by *Mayhew*. Accordingly, the 35 U.S.C. §102 rejection of claim 5 should be withdrawn, notwithstanding the allowability of claim 4.

In addition, claim 6 recites “receiving an input subsequent to the executing step” and performing the determining step in response to the receiving step.” For at least the reasons set forth hereinabove in the arguments for allowance of claim 3, Applicant asserts that the foregoing features of claim 6 are not disclosed by *Mayhew*. Accordingly, the 35 U.S.C. §102 rejection of claim 6 should be withdrawn, notwithstanding the allowability of claim 4.

Claim 7

Claim 7 presently stands rejected under 35 U.S.C. §102 as allegedly anticipated by *Mayhew*. Amended claim 7 reads as follows:

7. An iconic programming computer system containing an existing network of connected icons, the system comprising:
a display device; and
logic configured to execute a plurality of the icons being displayed on the display device during a run of a software program and provide an indication as to which of the icons are executed during the run, ***the logic further configured to make a determination, subsequent to the run and based on the indication, that the plurality of icons have been executed and highlight the plurality of executed icons on the display device in response to the determination.*** (Emphasis added)

For at least the reasons set forth above in the arguments for allowance of claim 4, Applicant asserts that *Mayhew* fails to disclose at least the features of claim 7 highlighted above. Accordingly, the 35 U.S.C. §102 rejection of claim 7 is improper.

In addition, claim 7 specifically recites that the “determination” on which highlighting of the icons is based occurs “subsequent to” a run of a software program during that executes the icons. It does not appear that such features are disclosed in *Mayhew*. In this regard, *Mayhew* appears to disclose a system that:

“[d]uring the application program procedure, the presentation of a graphical icon is modified to indicate a readiness of an associated job to execute. Thereafter, the user selects the associated job for execution by entering a selection signal. The graphical icon’s presentation is modified to indicate completion of execution of the associated job and the presentations of one or more connectors are modified to indicate a completion of execution.”

See *Mayhew*, Abstract; column 2, lines 14-22. Specifically, *Mayhew* discloses that after a task is run, “the icon associated with the task ...is successively changed to indicate the current status of the task.” See *Mayhew*, columns 4, lines 46-48. After each job in the application program procedure, the associated icon is modified to indicate that the job has executed. Thus, it appears that any “determination” on which the highlighting of a plurality of icons in *Mayhew* is based occurs **during**, not after, the run of the software program that executes the icons. Thus, *Mayhew* fails to disclose highlighting a plurality of icons “in response to” a “determination” that occurs “subsequent to the run” of a software program, as described by claim 7. Therefore, the 35 U.S.C. §102 rejection of claim 7 should be withdrawn, notwithstanding the allowability of claim 4.

For at least the above reasons, Applicant respectfully asserts that the 35 U.S.C. §102 of claim 7 is improper and should be withdrawn.

Claim 8-10

Claims 8 and 9 presently stand rejected under 35 U.S.C. §102 as allegedly anticipated by *Mayhew*. Dependent claims 8-10 contain all features of their respective independent claim 7. Since claim 7 should be allowed, as argued hereinabove, pending dependent claims 8-10 should be allowed for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Furthermore, these dependent claims recite patentably distinct features and/or combinations of features that make them allowable, notwithstanding the allowability of their base claim 7.

For example, claim 8 recites “wherein the logic is further configured to set, during the run, a plurality of flags respectively corresponding with the plurality of icons, and wherein the indication is based on the flags.” For at least the reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant asserts that the foregoing features of claim 8 are not disclosed by *Mayhew*. Accordingly, the 35 U.S.C. §102 rejection of claim 8 should be withdrawn, notwithstanding the allowability of claim 7.

In addition, claim 9 recites “wherein the logic is further configured to receive an input subsequent to the run and perform the determination in response to the input.” For at least the reasons set forth hereinabove in the arguments for allowance of claim 3, Applicant asserts that the foregoing features of claim 9 are not disclosed by *Mayhew*. Accordingly, the 35 U.S.C. §102 rejection of claim 9 should be withdrawn, notwithstanding the allowability of claim 7.

Further, claim 10 recites “wherein the input is a user input.” As described above in the arguments for allowance of claim 3, *Mayhew* fails to disclose an “input,” as claimed. It is asserted, however, in the Office Action that *Mayhew* discloses the “input” recited by claim 10 at column 2, lines 16-17. Applicant respectfully disagrees. In this regard, the “input” described at the cited section of *Mayhew* appears to select a job to be executed.

Thus, the input appears to be received *prior to* execution of an icon. The "input" of dependent claim 10, when read in conjunction with its corresponding claims 7 and 9, is received "*subsequent to* the run" during which the icons are executed. Thus, the alleged "input" of *Mayhew* cannot constitute the "input" recited by claim 10. For at least the foregoing reasons, Applicant respectfully asserts that the 35 U.S.C. §102 rejection of claim 10 is improper and should be withdrawn, notwithstanding the allowability of claim 7.

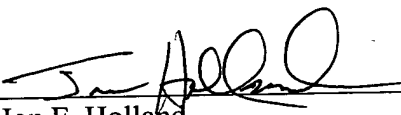
CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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